

REMARKS

Claims 1-3, 5-8, 13, 14, 16-21, 23-26, 31, 32, and 34-36 are pending. Claims 13-14 and 31-32 were withdrawn. Claims 4, 9-12, 15, 22, 27-30 were previously canceled. Claim 33 is canceled by this communication. Claims 1-3, 5-8, 16-21, 23-26, and 34-36 are rejected.

Claims 1 and 19 are amended to specifically define the term “carboxylated poly(lactic acid)”. This amendment does not present new issue for examination.

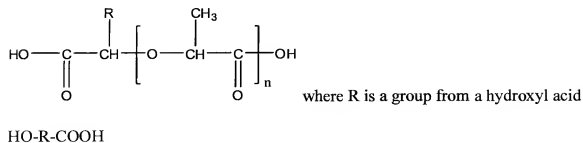
Amendment to the specification

The amendment to the specification at page 12 corrects an obvious error by Applicants in the chemical structure representing a carboxylated poly(lactic acid). This amendment does not introduce any new matter to the application.

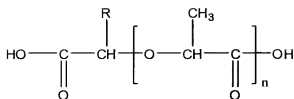
Rejections under 35 U.S.C. § 102

Claims 1-3, 5-8, 16-21, 23-26, and 34-36 are rejected under 35 U.S.C. 102 (b) as being anticipated by Yang et al. (US 6,258,121 B1) and the teachings of Kim et al. (U.S. Patent No. 5,548,035) (“Kim”) incorporated by Yang.

Claims 1 and 19 recite a coating including a polymer comprising a carboxylated poly(lactic acid), or a block-copolymer having at least one moiety comprising a carboxylated poly(lactic acid). The carboxylated poly(lactic acid) comprises a structure of



As pointed out in previous communications, Yang describes a coating that can include a poly(lactic acid)-co-poly(ethylene oxide) (PLA-PEO) co-polymer. Kim describes PLA-PEO-PLA tri-block copolymer. Yang and Kim fail to teach a coating having a polymer comprising



where R is a group from a hydroxyl acid

HO-R-COOH. Accordingly, claims 1 and 19 are patentably allowable over Yang under 35 U.S.C. §102(b). Claims 2, 3, 5-8, and 16-18, which depend from claim 1, and claims 20, 21, 23-26 and 34-36, which depend from claim 19, are all patentably allowable over Yang under 35 U.S.C. §102(b) for at least the same reason.

Claims 1-3, 5, 6, 8, 16-24, 26, and 34-36 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. patent No. 5,206,341 to Ibay et al. (“Ibay”).

Ibay describes a polymer formed of hydroxyalkanoic acid by polycondensation of the hydroxyalkanoic acid (col. 6, lines 46-58) in the presence of a polycarboxylic component (col. 2, lines 43-68). The polymer thus formed would have at least 90% or preferably 100% carboxylic terminal groups (col. 5, lines 15-27). It is apparent to a person of ordinary skill in the art that Ibay teaches achieving a high percentage of carboxylic terminal group in the polymer via condensation reaction of a terminal OH (hydroxyl) group in the polymer (by polycondensation of hydroxyalkanoic acid) with a carboxylic group in the polycarboxylic component, which removes the hydroxyl group by forming an ester grouping. As such, to a person of ordinary skill in the art, Ibay cannot use a hydroxyl acid (HO-R-COOH) to remove a terminal OH (hydroxyl) group in the polymer by polycondensation of hydroxyalkanoic acid since a condensation reaction between the terminal OH (hydroxyl) group in the polymer and HO-R-COOH would result in a hydroxyl ester, generating a new terminal HO group. Note, Ibay states that it is essential not to include reactants in the polycondensation of hydroxyalkanoic acid such as “di and poly-functional reactants such as dihydroxyalkanes and polyols or monohydroxy alcohols” “in an amount that would result in the polymer having less than about 90% of its end groups being

carboxyl end groups” (col. 5, lines 15-21). Therefore, it is clear to a person of ordinary skill in the art that the polymer described in Ibay does not include a carboxylated poly(lactic acid) as defined by any of claims 1-3, 5, 6, 8, 16-24, 26, and 34-36, and thus, Ibay cannot anticipate any of claims 1-3, 5, 6, 8, 16-24, 26, and 34-36.

In sum, claims 1-3, 5, 6, 8, 16-24, 26, and 34-36 are patentably allowable over Ibay under 35 U.S.C. §102(b).

The undersigned authorizes the examiner to charge any fees that may be required or credit of any overpayment to be made to Deposit Account No. 07-1850.

CONCLUSION

Withdrawal of the rejection and allowance of the claims are respectfully requested. **If the Examiner has any suggestions or amendments to the claims to place the claims in condition for allowance, applicant would prefer a telephone call to the undersigned attorney for approval of an Examiner's amendment.** If the Examiner has any questions or concerns, the Examiner is invited to telephone the undersigned attorney at (415) 393-9885.

Respectfully submitted,

Date: September 29, 2008
Squire, Sanders & Dempsey L.L.P.
One Maritime Plaza, Suite 300
San Francisco, CA 94111
Telephone (415) 393-9885
Facsimile (415) 393-9887

/ZLI/
Zhaoyang Li, Ph.D., Esq.
Attorney for the Applicant
Reg. No. 46,872